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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,219	09/28/2001	David B. Kumhyr	AUS920010402US1	7154

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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,219

Applicant(s)

KUMHYR ET AL.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-22, 24-33 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) 18-22, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-17, 26-33 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the amendment filed 02 September 2005.
2. Claims 1-10, 13-22, 24-33, 36-39 are presented for examination.

Response to Amendment

3. Regarding the Amendment filed 02 September 2005, Examiner has carefully reviewed the Declaration under 37 CFR 1.131 as well as the amendments made to the claimed invention. After careful review, Examiner has found the Declaration to be ineffective, and the claim amendments requiring restriction to the claims of the invention previously claimed, as shown below.

Response to Declaration Under 37 CFR 1.131

4. With respect to applicant's argument that the Declaration under 37 CFR 1.131, filed on 02 September 2005, has effectively, "sworn behind" the Rudd reference, examiner respectfully disagrees.
5. An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
6. The instant declaration does not appear to clearly point out the claims under rejection. The instant declaration also does not appear to clearly point out that the co-inventor, David Kumhyr, is the "sole" inventor of the claims under rejection. Therefore the Declaration is improper. See MPEP 715.04, Section I., Part B.

Conception

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

Vague and general statements in broad terms about what the exhibits describe along with a general assertion... does not satisfy the requirements of 37 CFR 1.131 (b). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by applicant. MPEP 715.07.

7. The instant declaration does not appear to clearly explain the exhibits, pointing out exactly what facts are established and relied upon by applicant. Therefore, applicant does not appear to have met his burden.

In the instant declaration, applicant argues that,

“Exhibit A described the broad concepts behind the ‘scatter/gather method,’ a label given to the presently claimed method of using two or more communications applications for sending different portions of a message.”

This is a general statement of what the exhibit shows and does not amount to “a clear explanation of the exhibits pointing out exactly what facts are established...”.

Examiner has reviewed the exhibits in their entirety affording them appropriate weight to determine what the disclose.

After careful review of the declaration and exhibits in their entirety, Examiner respectfully disagrees with Applicant's assertion that they show conception of the **claimed** invention.

By way of example, neither Exhibit A or Exhibit B appear to disclose,

"dividing the message into separate portions appropriate for sending by the respective selected communications applications; and

sending each separate portion of the message using a different one of the selected communications applications, such that the entirety of the message is sent,"

with respect to independent claims 1, 18, 26, 37, using actual language of claim 1 as representative here in interest of efficiency.

8. Applicant is reminded that the burden is on Applicant to substantiate the prior conception in order to antedate a reference. Examiner does not have the burden to search through the exhibits to discover their inadequacy.

Election/Restrictions

9. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-10, 13-17, 26-33, and 36-39 are drawn to a communications system that integrates multiple communications applications to send a message, classified in Class 709, subclass 206.

II. Claims 18-22, and 24-25 are drawn to a communications system that sends a message based on a characteristic of transmission, classified in Class 709, subclass 232.

10. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as selecting two or more communications applications, dividing a message into portions, and sending each portion with a different selected communication application classified in different Classes/subclasses. And, this combination, Invention I, as claimed does not require the particulars of the subcombination as claimed because Invention I does not explicitly require the selection to be based on a characteristic of transmission. The subcombination has separate utility such as determining which communications applications to use to send the message based on a characteristic of the transmission received from the sender, classified in a different Class/subclass. See M.P.E.P. § 806.05(d).

11. These inventions are distinct for the reasons given above, and the search required for each Group is different, as shown the above Class/subclass classifications, and not co-extensive for examination purpose.

12. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 18-22, and 24-25 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

13. Since the claims have been constructively elected by original presentation for prosecution on the merits, along with the Declaration being ineffective, the prior rejection in the previous office action is respectfully maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JBD



WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER